

REMARKS

I. Introduction

With the cancellation of claim 15, claims 11 to 13, 17 to 22, and 24 to 27 are pending in the present application. In view of the following amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of claims 11 to 27 under 35 U.S.C. §103(a)

A. Rejection of claims 11 to 14, 16, 20 to 24 and 27

The Examiner rejected claims 11 to 14, 16, 20 to 24 and 27 under 35 U.S.C. §103(a) as being unpatentable over French reference to Decathlon Production 560,698 ("Decathlon") in view of U.S. Patent No. 4,878,301, issued to Kiyosawa ("Kiyosawa"). Claims 14, 16 and 23 have been previously canceled, thus rendering the rejection of these claims moots. Applicants submit that claims 11 to 13, 20 to 22, 24 and 27 are patentable over the combination of Decathlon and Kiyosawa for the following reasons.

Claim 11 relates to a shoe for promoting a heel-to-toe motion of a foot. Claim 1 recites that the shoe includes an outsole and an upper part. Claim 1 further recites that the outsole has a contraction, the contraction extending to a first area where a back of the foot is located. Claim 1 further recites that a heel guide for a heel of the foot is provided in the upper part, the heel guide having one of a heelplate and a flexible heel brace arranged in a second area where the heel of the foot is located and configured such that the Achilles tendon of the foot is free. Claim 1 has been amended to recite that the one of the heelplate and the flexible heel brace has a smaller height above the outsole in an area of an Achilles tendon of the foot than in the area of a front heel bone of the foot. Claim 1 has further been amended to recite that in an area of the front of the foot the outsole

has a profiling configured to provide for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot. No new matter has been added. See the Specification, for example, at p. 6, lines 12 to 23 and claim 15.

The Examiner admits that Decathlon does not disclose a heel guide having a heel plate. See Final Office Action at p. 3. The Examiner alleges, however, that Kiyosawa teaches that a shoe can have a heel counter attached to it to aid in supporting the heel of a user. See Final Office Action at p. 3. The Examiner concludes that it would have been obvious to make the heel counter of Decathlon out of a hard elastic heel plate, as purportedly taught by Kiyosawa, to aid in balancing the heel of the user during use to aid in preventing pronation or supination. See Final Office Action pp. 3 to 4.

Kiyosawa recites a sports shoe stated to be provided with an upper 20, a shoe sole 21 and a heel counter 22. See col. 2, lines 67-68 and Col. 3, lines 1-2. The heel counter 22 is stated to include a heel side wall part 1. See col. 3, lines 4 to 5.

Nowhere does the combination of Decathlon and Kiyosawa disclose, or even suggest, one of the heelplate and the flexible heel brace having a smaller height above the outsole in an area of an Achilles tendon of the foot than in the area of a front heel bone of the foot, as recited in amended claim 11. Further, nowhere does the combination of Decathlon and Kiyosawa disclose, or even suggest, that in an area of the front of the foot the outsole has a profiling configured to provide for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot, as recited in amended claim 11. As can be seen in Figures 1 and 2 of Kiyosawa, the heel counter 22 does not extend downward towards the back of the shoe in the area of the Achilles tendon of the foot. Low surrounding heel counters, like the one in Kiyosawa, do not provide sufficient grip to the back of the foot. Hence, they can lead to an over pronation of a child's foot. This is in contrast to the present invention, which includes a heel counter that is pulled up on both

sides towards the metatarsus (calcaneus clamp). Therefore, the combination of Decathlon and Kiyosawa does not disclose all of the limitations of amended claim 11.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As more fully set forth above, nowhere does the combination of Decathlon and Kiyosawa disclose, or even suggest, one of the heelplate and the flexible heel brace having a smaller height above the outsole in an area of an Achilles tendon of the foot than in the area of a front heel bone of the foot, as recited in amended claim 11. Further, nowhere does the combination of Decathlon and Kiyosawa disclose, or even suggest, that in an area of the front of the foot the outsole has a profiling configured to provide for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot, as recited in amended claim 11. Therefore, the combination of Decathlon and Kiyosawa does not render obvious amended claim 11. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection and allowance of amended claim 11 is respectfully requested.

As for claims 12 to 13, 20 to 22, 24 and 27, which ultimately depend from claim 11 and therefore include all of the limitations of claim 11, it is respectfully submitted that the combination of Decathlon and Kiyosawa does not render obvious these dependent claims for at

least the same reasons given above in support of the patentability of claim 11. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

B. Rejection of claims 15, 17, 19 and 25

The Examiner rejected claims 15, 17, 19 and 25 under 35 U.S.C. §103(a) as being unpatentable over the Decathlon and Kiyosawa references, as applied to claim 11, in view of U.S. Patent No. 5,024,007, issued to DuFour ("DuFour"). Claim 15 has been canceled thus rendering the rejection of this claim moot. Applicants respectfully submit that the combination of Decathlon, Kiyosawa and DuFour does not render unpatentable claims 17, 19 and 25 for the following reasons.

Claim 17 has been amended so as to depend from claim 11 and further recites that the profiling has one of parallel grooves and ray-shaped grooves, the one of the parallel grooves and the ray-shaped grooves extending at least partially over a width of the shoe.

Claim 19 has been amended so as to depend from claim 11 and further recites that the profiling is made up of at least two materials having different elasticities.

Claim 25 depends from claim 17, ultimately from claim 11, and further recites that the profiling is made up of at least two materials having different elasticities.

The Final Office Action alleges that Decathlon and Kiyosawa disclose all the limitations of claims 15, 17, 19 and 25 except for the outsole having profiling for a greater flexibility of the outsole with regard to the heel-to-toe motion of the foot and having one of a parallel grooves and ray-shaped grooves, the grooves extending at least partially over a width of the shoe, and the profiling being made up of at least two materials having different elasticity. See Final Office Action at p. 4. The Final Office Action further alleges that DuFour teaches that the forefoot area of the sole of a shoe can have profiling made up of grooves and material filled within the grooves to aid in flexibility and gripping of the sole to the contact surface. See Final Office Action at p. 4. The Final

Office Action further alleges that DuFour teaches that the grooves can be parallel (Figure 1) and extend at least partially over a width of the sole of the shoe and made up of two materials (A and B), the materials having a different elasticity (col. 2, lines 56-68). See Final Office Action at p. 4. The Examiner concludes that it would have been obvious to make a profile, as purportedly shown in DuFour, on the sole of the shoes in Decathlon and Kiyosawa, to aid in making the sole flexible as well as still allowing grip. See Final Office Action at pp. 4 to 5. Applicants respectfully disagree.

Given the ultimate dependence of claims 17, 19 and 25 on claim 11, Applicants respectfully reassert the arguments made above in reference to the rejection of claim 11. As stated above, to establish prima facie obviousness, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981. Respectfully, nowhere does the combination of Decathlon, Kiyosawa and DuFour disclose, or even suggest, one of the heelplate and the flexible heel brace having a smaller height above the outsole in an area of an Achilles tendon of the foot than in the area of a front heel bone of the foot, as recited in amended claim 11. Further, nowhere does the combination of Decathlon, Kiyosawa and DuFour disclose, or even suggest, that in an area of the front of the foot the outsole has a profiling configured to provide for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot, as recited in amended claim 11. Therefore, the combination of Decathlon, Kiyosawa and DuFour does not render obvious claims 17, 19 and 25, which ultimately depend from amended claim 11. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 17, 19 and 25 is respectfully requested.

C. Rejection of claims 18 and 26

Claims 18 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Decathlon, Kiyosawa and DuFour references, as applied to claim 17, in view of the French reference to Scop Minibel Sa Societe Anonyme 2,739,533 ("Scop").

Claim 18 depends from 17, ultimately from claim 11, and further recites that the one of the parallel grooves and the ray-shaped grooves extend over the entire width of the shoe.

Claim 26 depends from claim 18, ultimately from claim 11, and further recites that the profiling is made up of at least two materials having different elasticities.

The Final Office Action alleges that the references, as applied to claim 17, disclose all of the limitations of the claims except for the grooves extending over the entire width of the shoe. See Final Office Action at p. 5. The Final Office Action further alleges that Scop teaches that grooves 5 made in the forefoot of the shoe for flexibility of the sole can extend the entire width of the shoe to allow the sole to flex with the normal flexing of the user's foot. See Final Office Action at p. 5. The Final Office Action concludes that it would have been obvious to make the grooves of the references as applied to claim 17 across the entire shoe to aid in flexing the sole with the normal flexing of the user's foot. See Final Office Action at p. 5. Applicants respectfully disagree.

Given the dependence of claims 18 and 26 on claim 17 and their ultimate dependence on claim 11, Applicants respectfully reassert the arguments made above in reference to the rejection of claim 11. As stated above, to establish prima facie obviousness, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981. It is respectfully submitted that the combination of Decathlon, Kiyosawa, DuFour and Scop does not disclose, or even suggest, one of the heelplate and the flexible heel brace having a smaller height above the outsole in an area of an Achilles tendon of the foot than in the area of a front heel bone of the foot, as recited in amended claim 11. Further, nowhere does the combination of Decathlon,

Kiyosawa, DuFour and Scop disclose, or even suggest, that in an area of the front of the foot the outsole has a profiling configured to provide for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot, as recited in amended claim 11. Applicants further submit that the combination of Decathlon, Kiyosawa, DuFour and Scop does not disclose, or even suggest, an area of the front of the foot in which the outsole has a profiling configured to provide for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot, as recited in claim 11. Given the configuration of the Scop outsole, including a few narrowly spaced parallel indentations, the Scop outsole simply cannot meet the functional demands of flexibility for the forefoot.

Therefore, the combination of Decathlon, Kiyosawa, DuFour and Scop does not render obvious claims 18 and 26, which ultimately depend from amended claim 11. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 18 and 26 is respectfully requested.

III. Conclusion


It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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